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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/137,393 08/20/98 DEWANJEE

P DSCK-525-C3

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EXAMINER

SERGEANT, R

ART UNIT

PAPER NUMBER

1711

10

DATE MAILED: 2/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/137,393

Applicant(s)
Dewanjee et al.

Examiner
Rabon Sergeant

Group Art Unit
1711



☒ Responsive to communication(s) filed on Sep 17, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 30-43 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 30-43 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terminology, "toluene diisocyanate at 6 percent nitrogen, carbon, oxygen content", is not understood. The examiner questions if applicants intended to specify the NCO content (or isocyanate content).

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 30-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-12 of copending Application No. 09/018,283. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill to utilize the claimed composition with a core to yield the instantly claimed golf ball. Furthermore, applicants' claimed process is considered to be obvious over the process of 09/018,283, because the instant process differs only in that limitations have been added to adapt the process for use on a conveyor; the use of a conveyor and the attendant alignment equipment is considered to be an obvious design choice.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 30-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. ('852) or GB 2,301,291, each in view of Wu ('673) and Isaac ('568) and Presswood ('298).

The primary references disclose the production of thread wound-solid center golf balls wherein the winding and center are comprised of components which are equivalent to those claimed by applicants. See columns 2-5 and tables within Kato et al. See pages 7-9 and examples within GB 2301291.

6. While the primary references are largely silent regarding the use of polyurethane covers, the use of such covers utilizing applicants' claimed prepolymer and blends of curing agents having different reactivities was known at the time of invention. Wu discloses the use of prepolymers based on diisocyanates and polytetramethylene ether glycol and a slow reacting polyamine, such as 3,5-dimethylthio toluenediamine. See column 2. Isaac discloses

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the use of curing agents having different reactivities for the production of golf

ball covers derived from polyurethane prepolymers. See columns 2 and 3.

7. Though Isaac fails to disclose applicants' specific blend of fast and slow reacting diamines, the use of blends of diethyl toluene diamine with 3,5-dimethylthio toluene diamine to produce polyurethanes having controlled reaction profiles and improved properties was known at the time of the invention. This position is supported by the teachings of Presswood at columns 2-4. Presswood further discloses the relative reactivities of the specified chain extenders.

8. Therefore, since it was known to employ blends of curing agents having different reactivities for the production of polyurethane golf ball covers and since it was known to employ diamines of the nature claimed by applicants to cure prepolymers, useful for producing golf ball covers, it would have been obvious to one of ordinary skill in the art to utilize the curing agent blend of Presswood with the prepolymer of Wu in accordance with the teachings of Isaac, so as to obtain a golf ball cover composition suitable for use with the wound cores of the primary references.

9. Applicants' arguments have been fully considered; however, the position is maintained for the aforementioned reasons that the teachings of references when considered in light of one another render the use of curing agents derived from components having different rates of reaction to cure polyurethane prepolymer compositions suitable for use in the production of golf ball covers prima facie obvious. Furthermore, applicants' arguments pertaining to the ability of polyurethanes to yield thin golf ball covers, as compared to the use of other materials, are not considered to set forth a new or unexpected concept. Isaac discloses at column 3, lines 59+ that a great advantage of using polyurethane as the cover is that the golf ball covers may be made very thin and that the core size may be increased.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, ~~THIS ACTION IS MADE FINAL~~. See MPEP § 706.07(a).

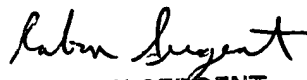
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

Sergent/mm

December 14, 1999


RABON SERGENT
PRIMARY EXAMINER